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10/732,911

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Bruce J. Cardinal

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EXAMINER

BAHTA, KIDEST

ART UNIT

PAPER NUMBER

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MAIL DATE

DELIVERY MODE

01/15/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte:* BRUCE CARDINAL, GORDON STEWART,  
GREGOR BERKOWITZ AND MICHAEL FOGARTY

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Application No. 10/732,911  
Technology Center 2100

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Mailed: January 15, 2009

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Before TOI JOHNSON *Review Paralegal*  
JOHNSON, *Review Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on June 11, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the

application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

APPEAL BRIEF,

Grounds of Rejection

A review of the file finds that the grounds of rejection of the claims as provided in the Appeal Brief filed April 26, 2007 under the heading “Grounds of rejection to be reviewed on appeal” is not consistent with the grounds of rejection of claims of record. The grounds of rejection of the claims as provided in the Appeal Brief must be consistent with the Final Rejection mailed September 11, 2006. Each Grounds of rejection to be reviewed on appeal must be identified.

The Final Rejection lists the grounds of rejections as follows:

1. Claims 1, 4, 7-20, 23-29 and 34-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Oliver (U.S. Patent 5,870,302).
2. Claims 2-3, 5-6, 21-22 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oliver (U.S. Patent 5,870,302) in view of Peek et al. (U. S. Patent 6,675,098).
3. Claims 64-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oliver (U.S. Patent 5,870,302) in view of Goldberg (US 6,647,319).
4. Claims 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oliver (U.S. Patent 5,870,302) in view of Addink et al. (US 2003/0182022).

Whereas Appellants have improperly listed the grounds or rejection as follow:

Claims 1 - 67 stand rejected under 35 U.S.C. 35 U.S.C. 102(b).

Correction of the Grounds of rejection to be reviewed on appeal for all claims is required.

### Arguments

A review of the file finds that the arguments with respect to each grounds of rejection as provided in the Appeal Brief filed under the heading “Argument” have not been clearly provided. Each grounds of rejection must be treated under a separate heading in accordance with 37 CFR 41.37(c)(1)(vii). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

Appellant has not provided the necessary headings and/or subheadings for arguments which correspond to each grounds of rejection. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8<sup>th</sup> ed. Rev. 6, Sept 2007) for details.

INCONSISTENCIES WITH THE FINAL  
REJECTION, APPEAL BRIEF AND EXAMINER'S ANSWER

A review of the file finds inconsistencies between the last rejection of record, corresponding sections in the Appeal Brief and the Examiner's Answer as set forth below.

Final Rejection

A review of the Final Rejection mailed on September 11, 2006, finds the following status of the claims: claims cancelled: NONE, claims allowed: NONE, claims rejected: 1-67 and claims withdrawn: NONE.

A further review of the file finds that claims 61-63 were pending in an amendment filed on May 16, 2007 however; the Final Rejection did not discuss the status of claims 61-63.

Appeal Brief

A review of the Appeal Brief filed on April 26, 2007, finds that the status of claims section indicates that claims 1-67 are on appeal.

Examiner's Answer

A review of the Examiner's Answer mailed on August 22, 2007, finds that the status of claims 61-63 is unclear as compared to both the Appeal Brief's and Examiner's Answer Status of Claims section.

Specifically, claims 61-63 is not included in any statement of rejection for review by the Board of Patent Appeals and Interferences.

Correction is required.

### CONCLUSION

Accordingly, it is ORDERED that the application is returned to the Examiner to:

- 1) vacate the Examiner's Answer mailed on August 22, 2007,
- 2) issue a Supplemental Examiner's Answer that address claims 61-63 and to correct other sections of the Answer as may be required;
- 3) include the necessary approval from the TC Director or designee in accordance with MPEP 1207.05, part (B) as may be required for any new grounds of rejection;
- 4) hold the Appeal Brief filed April 26, 2007 defective, as required by 37 CFR § 41.37(d);
- 5) notify the Appellant to submit a Supplemental Appeal Brief which corrects the Appeal Brief's Grounds of Rejection to be Reviewed on Appeal and the Arguments section under 37 CFR §41.37(c)(1)(vi)(vii);
- 6) acknowledge and consider the Supplemental Appeal Brief submitted by Appellant to correct the Appeal Brief; and
- 7) for such further action as may be appropriate.

Application No. 10/732,911

If there are any questions pertaining to this Order, please contact the  
Board of Patent Appeals and Interferences at 571-272-9797.

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